*IN THE UNITED STATES PATENT AND TRADEMARK OFFICE*

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| In re application of: Alexander B. BEAMAN | Attorney Docket No.: APL1P283/P3109US1 |
| Application No.: 10/623,339 | Examiner: Steven B. Theriault |
| Filed: July 18, 2003 | Group: 2179 |
| Title: VOICE MENU SYSTEM | Confirmation No. 3294 |

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I hereby certify that this correspondence is being transmitted electronically through EFS-WEB to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 on **March 10, 2008**.

Signed: /Lydie Fitzsimmons/
Lydie Fitzsimmons

# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop **AF**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated below.

The main issue on Appeal is the effectiveness of the Affidavit filed on 10/11/2007. This affidavit was submitted to establish conception of the invention prior to the effective date of the Born et al. reference and to establish subsequent diligence in constructively reducing the invention to practice by virtue of filing the present patent application.

The Affidavit presents facts that the invention was conceived no later than March 3, 2003. The Examiner does not challenge this conception date, and as such Applicant does not believe that this fact is at issue in this Appeal.

The Affidavit establishes diligence in constructively reducing the invention to practice via several facts. Specifically, the Affidavit establishes that the invention was submitted to the online patent disclosure repository of Apple Computer, Inc. on March 3, 2003, that from March 3, 2003 to May 20, 2003, Apple Computer, Inc's patent review committee was diligently evaluating the proposed idea to determine whether to file a patent application on it, and that on May 20, 2003, Apple Computer, Inc. sent a letter to Patent Attorney Doug Thomas requesting an

estimate for the cost of preparing a patent application and a sample claim. The Affidavit also establishes that the inventor then began working with Mr. Thomas to prepare the actual application.

The Examiner argues that this fails to establish diligence in reducing the invention to practice for two reasons. First, the Examiner argues that the May 20, 2003 letter to Mr. Thomas states that authorization to proceed with the application would only occur once a sample claim and an estimate were provided by Mr. Thomas. The Examiner apparently feels that the time that Mr. Thomas spent preparing an estimate and preparing a sample claim does not constitute reasonable diligence. Second, the Examiner argues that the time the Apple patent review committee spent reviewing the proposed idea suggests a period of inactivity in order to exploit the invention commercially rather than diligence in reducing the invention to practice. Applicant strongly disagrees with both points for the following reasons.

As to the Examiner's first point, the Applicant respectfully asserts that preparing of an estimate and a sample claim for an invention **is** diligently reducing the invention to practice. The fact that final authorization to complete the entire task of preparing and filing the patent application is held back until an estimate is given and sample claims reviewed is not relevant to the analysis. The M.P.E.P. does not require that the Applicant follow the conception date by immediately grant an attorney full authority to file an application in the USPTO. The M.P.E.P. requires only that the Applicant act with reasonable diligence. Requesting that an attorney review a written disclosure, draft a sample claim, and provide a cost estimate are reasonably diligent steps to take during the preparation of a patent application. It should also be noted that the attorney's work in performing these acts would involve learning about the patent application and undertaking an analysis of the complexity and feasibility of obtaining patent protection, also reasonable steps to take during the preparation of a patent application. Preparing a patent application is an expensive process, and one that is not undertaken lightly, as such it is not only reasonable but expected that an applicant would want to obtain a cost estimate and a sample claim to review prior to committing to such an expensive proposition.

As to the Examiner's second point, the Examiner has assumed facts not in evidence and indeed the facts the Examiner has assumed are incorrect. The Examiner apparently is unfamiliar with what a patent review committee is and what they do. All large corporations that pursue large numbers of patents have committee set up to determine which ideas to patent and which ideas are not worth patenting. As one could imagine, a company as large as Apple Computer has a large number of employees who conceive of an extremely large number of potentially patentable ideas. A patent review committee is a mechanism companies use to help facilitate the

process of pursuing patents, by filtering out the ideas to pursue as patents from the ones that should not be pursued. A number of factors go into this analysis, including the patentability of the idea, the cost of pursuing patent protection, the potential benefit to the company, etc. These analyses are reasonably diligent steps to take in securing patent protection.

There is no evidence at all to support the Examiner's suggestion that the time taken by the patent review committee to review the idea represents a period of inactivity to exploit the invention commercially. Indeed, such an assumption is quite unreasonable. If such an assumption were taken as fact, then no large companies would be able to obtain patent protection as any time spent by a patent review committee would be deemed to be lack of reasonable diligence. Indeed, such an assumption would render a large percentage of outstanding patents invalid.

Furthermore, Apple Computer is not a small company and is not a company that keeps its products secret. Indeed, Apple Computer, as the Examiner is well aware, is involved in the mass marketing of products to consumers around the world. If the Examiner truly believes that attempts were made to commercially exploit the invention between March 3, 2003 and May 20, 2003, the Examiner would certainly be able to find evidence of such a commercial exploitation (e.g., a press release describing a new product, a product manual, newsgroup discussions of the product). No such evidence has been presented by the Examiner, because in fact the invention was not commercially exploited during that period.

Indeed, it is perplexing to the Applicant that the Patent Office is arguing that acts taken to determine patentability of a potential idea do not represent reasonable diligence in reducing the invention to practice. Not only are such acts reasonable, but recently proposed legislation from the PTO suggests that in fact the PTO would **prefer** that the Applicant perform significant pre-filing acts to determine the patentability of a patent application, including, for example, preparation of a report outlining the patentability of each submitted claim.

The M.P.E.P. only requires that an Applicant undertake **reasonable** diligence in reducing an invention to practice. The Examiner, on the other hand, appears to be requiring **exceptional** diligence. Indeed, judging by the Examiners standard of diligence, Applicant believes the only way that Apple Computer could have convinced the Examiner of the diligent reduction to practice of the invention would be to conceive of the invention one day, hire an attorney and authorize him to prepare the application the very next day, and then file the application within a week. Such a standard, however, is unreasonable.

or the above reasons, Applicant respectfully asserts that the Affidavit is valid and the underlying rejection should be withdrawn.

am the attorney or agent acting under 37 CFR 1.34

Respectfully submitted,
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